III. REMARKS:

A. Status of the Claims

Claim 1 was originally filed with the case. Claim 1 is amended and Claims 2-14 are added herein. Support for the amendments and for the added claims can be found in the specification at page 3, lines 3- 16. Thus, claims 1-14 are currently pending.

B. The Claims are Enabled

The Action rejects claim 1 as lacking enablement for the scope of the claim. According to the Action, the specification does not provide enablement for treating unknown damage with structurally uncharacterized proteins. Applicants respectfully traverse.

The Action acknowledges that the specification is enabling for decreasing retinal ganglion cell death by administering an effective amount of ADNF as structurally defined by Brenneman. Claim 1 has been amended and claims 2-14 have been added to more clearly define the scope of the invention. It is submitted that the amendments to claim 1 and the added claims address the Actions concerns raised in the enablement rejection.

In light of the foregoing arguments, Applicants respectfully request that the enablement rejection be withdrawn.

C. The Claims are Not Anticipated

The Action next rejects claim 1 as being anticipated by Gozes *et al.* (WO 98/35042). Gozes is said to teach treatment of "retinal neuronal degeneration" with pharmaceutically effective amounts of ADNF polypeptides. Applicants respectfully traverse.

As explained in the present application at page 2, lines 25-28, Gozes discusses the use of ADNF III, also known as ADNP (Gozes, page 1, lines 2-4), for conditions leading to neuronal cell death. Gozes further describes the discovery of ADNF (also known as ADNF I;

page 3, lines 11-21) and active peptide fragments of ADNF (page 3, lines 23-32). A close reading reveals that ADNF III and ADNF are not the same protein. ADNF is described in Gozes as having the capability of protecting neurons from death associated with toxins relating to Alzheimer's disease, the human immunodeficiency virus (HIV), excitotoxicity, and electrical blockade. There is no mention within Gozes that ADNF would be useful for treating retinal and/or optic nerve head damage.

It is well known that for a prior art reference to render a claim anticipated, that reference must set forth every element in the claim, either expressly or inherently. *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983)). In other words, to support a rejection under section 102, a reference must show ***all*** features of the rejected claim(s). *Minnesota Mining & Mfg. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1569, 24 USPQ2d 1321 (Fed. Cir. 1992). The Federal Circuit has stated that "absence of a claim element from a prior art reference negates anticipation." *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 U.S.P.Q. 409 (Fed. Cir. 1984). Since Gozes lacks a teaching of the use of ADNF peptides or proteins for the treatment of retinal and/or optic nerve head damage, but rather discusses a different protein from ADNF, it is submitted that Gozes does not anticipate the claimed invention.

In light of the foregoing arguments, it is respectfully requested that the anticipation rejection based on Gozes be withdrawn.

D. Conclusion

This is submitted to be a complete response to the outstanding Action. Based on the foregoing arguments, the claims are believed to be in condition for allowance; a notice of allowability is therefore respectfully requested.

The Examiner is invited to contact the undersigned attorney at (817) 551-4321 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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